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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188973
Party	Plaintiff Gapardis Health and Beauty, Inc.
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>GAPARDIS HEALTH AND BEAUTY, INC. and XAVIER P. TANCOGNE,</b>	)	Opposition No. 91188973 Serial No. 77248780
	)	
<b>Opposers,</b>	)	
	)	
<b>v.</b>	)	
	)	
<b>GULAM NASSER,</b>	)	
	)	
<b>Applicant.</b>	)	
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**OPPOSERS' MOTION TO STRIKE AFFIRMATIVE DEFENSE**

In his Amended Answer, Applicant asserts as an affirmative defense:

Opposers' claims are barred by the doctrines of laches, estoppel, or acquiescence, Applicant's marks and registration, and the marks and registrations of Opposers' coexist in France or the European Union without confusion.

This defense is legally insufficient and should be stricken pursuant to Rule 12(f), Federal Rules of Civil Procedure, and 37 C.F.R. §§ 2.116 and 2.126.

In opposition proceedings, laches is sometimes characterized as "acquiescence." *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991). The elements of laches are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. *Lincoln Logs, Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734-736 (Fed. Cir. 1992); *National Cable Television Association*, 937 F.2d at 1580, 19 USPQ2d at 1432.

Laches begins to run from the time action could be taken. In an opposition, where the objection is to the issuance of a registration of a



mark and the plaintiff had prior knowledge of applicant's use, laches starts to run when the mark in question is published for opposition.

*National Cable Television Association*, 937 F.2d at 1581, 19 USPQ2d at 1432); *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 2009 TTAB LEXIS 708, \*27-\*28; *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1210 n. 10 (TTAB 2006). Because Opposers timely filed their notice of opposition, there has been no undue delay or prejudice to Applicant. Laches and acquiescence are not sufficient defenses.

Similarly, the defense of estoppel is legally insufficient.

The elements of equitable estoppel are (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. [citation omitted]. As applied in trademark opposition or cancellation proceedings, these defenses must be tied to a party's registration of a mark, not to a party's use of the mark. *National Cable Television*, 937 F.2d at 1581, 19 USPQ2d at 1431.

*Lincoln Logs, Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734-736 (Fed. Cir. 1992); *Panda Travel*, 2009 TTAB LEXIS 708, at \*29. In the absence of allegations that the Opposers misled Applicant to reasonably infer that the would not oppose registration, the asserted defense of estoppel is insufficient.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Motion was served upon Applicant's counsel at the addresses below by U.S. Mail on the 2nd day of March, 2010:

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